

REMARKS

Group election and traversal

1. Paragraph 1 of the office action defines Group I as consisting of claims 1 to 12. Applicants assume that claims 1 to 11 is meant.
2. Applicants submit that the reasoning for the election requirement set out in the first paragraph 2 (starting on page 2) of the office action does not apply in respect of the claims as now amended, for the reasons set out below. Furthermore, although the examiner has given reasons why he considers the inventions of the previously presented claims are independent or distinct, he has not, contrary to MPEP808 and MPEP808.02, given any reasons at all why there would be a serious burden on the examiner if restriction were not required.
Nevertheless, applicants elect Group I drawn to the apparatus.
3. Applicants submit that amended method claim 12 of Group II and amended method claim 13 of Group III each require all of the limitations of amended apparatus claim 1 of Group I. Therefore, with reference to the first paragraph 3 (starting on page 3) of the office action and the second paragraph 3 (on page 6) of the office action, applicants reserve the right to rejoinder of the method claims of Groups II and III in the event that the apparatus claims of Group I are found to be allowable.
4. In paragraph 3 of the office action, Examiner states that Groups I, II, and II are related as process of making and product made. Examiner then applies MPEP 806.05(f). However, see MPEP 801:-

801 Introduction

This chapter is limited to a discussion of the subject of restriction and double patenting under Title 35 of the United States Code and Title 37 of the Code of Federal Regulations as it relates to national applications filed under 35 U.S.C. 111(a). The discussion of unity of invention under the Patent Cooperation Treaty Articles and Rules as it is applied as an International Searching Authority, International Preliminary Examining Authority, and in applications entering the National Stage under 35 U.S.C. 371 as a Designated or Elected Office in the U.S. Patent and Trademark Office is covered in Chapter 1800.

5. Since, this application was filed under 35 USC 371, the applicable procedure is found in MPEP 1800, and the applicable law is 37 CFR 1.475, excerpted below.

37 CFR 1.475 Unity of invention before the International Searching Authority, the International Preliminary Examining Authority and during the national stage.

...

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(1) A product and a process specially adapted for the manufacture of said product; or

(2) A product and a process of use of said product; or

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

(4) A process and an apparatus or means specifically designed for carrying out the said process; or

(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

...

6. In item (1) above, the criterion "specially adapted" is fulfilled by the claims as amended. See definition below. Furthermore, "specially adapted" does not mean that the product could not also be manufactured by a different process. This is made clear in MPEP 1850 excerpted below.

MPEP 1850 III A

A process is specially adapted for the manufacture of a product if it inherently results in the product and an apparatus or means is specifically designed for carrying out a process if the contribution over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art.

Thus, a process shall be considered to be specially adapted for the manufacture of a product if the claimed process inherently results in the claimed product with the technical relationship being present between the claimed product and claimed process. The words "specially adapted" are not intended to imply that the product could not also be manufactured by a different process.

7. Restriction among dependent claims is not supported if the independent claims satisfy unity and avoid the prior art, even if a dependent claim contains a further invention. As argued herein, the independent claims as amended do satisfy unity and avoid the prior art.

MPEP 1850 II

If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention.

8. The International Searching Authority found unity of invention, using the same criteria applicable to the present national stage.

MPEP 1850 I

Observance of this requirement [unity of invention] is checked by the International Searching Authority and may be relevant in the national (or regional) phase.

9. Furthermore, the following general guideline is applicable:

MPEP 1850 (I):

Although lack of unity of invention should certainly be raised in clear cases, it should neither be raised nor maintained on the basis of a narrow, literal or academic approach. There should be a broad, practical consideration of the degree of interdependence of the alternatives presented, in relation to the state of the art as revealed by the international search or, in accordance with PCT Article 33(6), by any additional document considered to be relevant.

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Species election

10. With reference to paragraphs 4 and 5 of the office action, applicants elect Species 5 disclosed in Figure 10.
11. Applicants point out that Figure 10 is one of three drawings, Figures 10 to 12, of the “fifth embodiment” of the invention described in particular at: page 7, line 28, to page 9, line 5; page 10, lines 20 to 32; and page 11, lines 3 to 10.
12. Applicants identify the claims, as amended, readable onto the elected species as: Claims 1 to 3, 5, 7, 8, 10, 11 and 18, and also claims 12 to 14 and 17 that are currently withdrawn from consideration.

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Prior art as related to the restriction requirement and traversal thereof

13. Applicants have considered DE 9012396 and DE 9419241 referred to in the first paragraph 2 (starting on page 2) of the office action, and have amended claim 1 so as to clarify the distinction of the invention over them.
14. For the assistance of the examiner, full translations of DE 9012396 and DE 9419241 are enclosed herewith.

15. Claim 1 has now been limited to (i) the features of original claim 6 and (ii) the feature of part of original claim 5 and (iii) the feature that when one housing is stacked inside another, said one housing extends into the recycling box space of said other housing. Support for limitation (iii) is to be found at original page 6, lines 6 to 9, and the drawings, particularly Figure 18.
16. Therefore, according to the invention of amended claim 1, the supporting means for the recycling box is arranged to be assembled with the housing and, prior to assembly of the supporting means with the housing and prior to insertion of such a recycling box, a plurality of identical such housings can be stacked one inside another so that said one housing extends into the recycling box space of said other housing. Accordingly, the housings take up less space prior to being put to use, for example when being stored at the factory, when being transported to the waste collection authority, and when being distributed to households.
17. In DE 9012396, the apparatus described with reference to Figures 1 to 4 has a space at the bottom which is open at the front. In Figures 1 and 2, the space is left open. In Figures 3 and 4, drawers 10,11 are inserted into the space. DE 9012396 does not say how the drawers are supported, but applicants guess that the lower drawer 11 would be supported on the lower base 6 of the housing 1, and the upper drawer 10 would be supported on the lower drawer 11. An intermediate base 9 is provided in the housing 1 above the upper drawer 10. DE 9012396 states that the housing consisting of the four side walls 2,3,4,5, the lower base 6 and the intermediate base 9 is preferably manufactured as a one-piece injection moulding.
18. Accordingly, amended claim 1 is distinguished from DE 9012396 inter alia by the following features:
 - *the supporting means ... are arranged to be assembled with the housing.* By contrast, in DE 9012396, the lower base 6 is disclosed as being moulded with the remainder of the housing; and
 - *the housing being such that ... a plurality of identical such housings can be stacked one inside another so that said one housing extends into the recycling box space of said other housing.* By contrast, in DE 9012396, the intermediate base 9 of said other housing would prevent said one housing being inserted that far into said other housing.
19. In DE 9419241, the housing has side walls 2,3 an open or part-open front, a base 1 and an intermediate base 9. In the drawings, the side walls 2,3 appear to be parallel, and there is no disclosure in DE 9419241 that the walls 2,3 are anything other than parallel. An upper box 11 is slid into the space above, and supported by, the intermediate base 9, and a lower box 11' is

slid into the space between the base 1 and intermediate base 9 and supported by the base 1. The container is made of plastics material. There is no disclosure in DE 9419241 that the intermediate base 9 is assembled with the remainder of the housing after the base 9 and the remainder of the housing have been made.

20. Accordingly, amended claim 1 is distinguished from DE 9419241 *inter alia* by the following features:
 - *the supporting means ... are arranged to be assembled with the housing; and*
 - *the housing being such that, prior to assembly of the supporting means ... with the housing and prior to insertion of such a recycling box, a plurality of identical such housings can be stacked one inside another so that said one housing extends into the recycling box space of said other housing.* By contrast, in DE 9419241, parallel side walls 2,3 would prevent such stacking.
21. For the above reasons, applicants submit that the invention of amended claim 1 is novel having regard to DE 9012396 and DE 9419241.
22. Applicants furthermore submit that the invention of amended claim 1 is not obvious. There is nothing in DE 9012396 and DE 9419241 to suggest the ‘stackability’ feature of amended claim 1. The apparatus of DE 9419241 is inherently non-stackable because of its parallel side walls. The apparatus of DE 9012396 seems to be based on a conventional stackable wheelie-bin, but the conventional wheelie-bin configuration is then modified in DE 9012396 to include the integrally-moulded intermediate base 9 so as to render the apparatus of DE 9012396 unable to be stacked to the extent required by amended claim 1. If anything, therefore, DE 9012396 points in the opposite direction to the present invention.

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Other amendments

23. In addition to the amendments to claim 1 to distinguish the invention more clearly from the prior art, claim 1 has, in order to simplify language, been amended to refer to “a space” rather than “at least one space”, and consequential amendments have been made elsewhere. Also, corrections of minor errors have been made.

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Summary

24. Applicants submit that they have responded fully to the election requirements.
25. Applicants have amended the only independent claim (claim 1) under consideration so that it is, in Applicants' view, clearly patentable having regard to the prior art referred to by the examiner and the other prior art listed in the International search report. Allowance of claim 1 is therefore respectfully requested.
26. The remaining apparatus claims (claims 2, 3, 5, 7, 8, 10, 11 and 18 to the elected species, and claims 4 and 9 to the non-elected species) are all dependent on claim 1, and therefore allowance of those claims is also respectfully requested.
27. The withdrawn but amended independent method claims (claims 12 and 13) include all of the limitations of claim 1, and the remaining method claims (14 and 16) are dependent claims. Accordingly, applicants respectfully request rejoinder of claims 12 to 14 and 17 and allowance thereof.

Respectfully submitted

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